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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,228	11/22/2000	Hiroyuki Kanemitsu	04739.0069	1506

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/27/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/717,228

Applicant(s)
Kanemitsu

Examiner
Victor Kostak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 18, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

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1. Applicant's arguments filed on 6/18/03 regarding all of the rejections have been fully considered but they are not persuasive, explained as follows.

Regarding the rejection based on Srinivasan, applicant alleges that the examiner has not identified any of the features recited in claim 1 in Srinivasan. That is not true. Furthermore, applicant limits the description and functionality of Srinivasan as being nothing more than downloading data from a network. Moreover, applicant does not address to any extent the obviousness and motivation for the rejection explicitly given by the examiner.

Applicant erroneously asserts (on page 6 of his response) that the examiner did not account for a reception means or a record means, although the examiner specified that "the programming to be received is sent to the user for recording on unit 20" (quoted from the last Office action). It is very clear that the communication between the headend and the user end - in any system - involves transmission and reception, which is the very nature of communication. The recorder of Srinivasan is therefore at the receiving end.

Applicant also argues that Srinivasan does not transmit broadcast data. The remote data communication system of Srinivasan, generally speaking, involves broadcast data because the headend of Srinivasan transmits data to any of plural users at remote sites (i.e. point-to-multi point communication) upon individual request. Broadcast data is not exclusive to wired or wireless data, nor does it require live or real-time data (and is similar to downloaded video-on-demand). It is further pointed out that Srinivasan mentions the worldwide web as an example of for downloading multimedia data communication medium (e.g. col. 1 lines 52-54), which

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thereby allows for any suitable medium to be used rather than forcing the skilled artisan to consider the Internet as the only option.

Applicant further argues that the examiner did not specify anywhere in Srinivasan where rerecord promote means is accounted for. The examiner is aware of such not being an explicit feature, which is why an obviousness rejection was made. The examiner gave an explicitly valid reason why promotion of rerecording would be prompted, in the last Office action. Because the applicant simply refuted the rejection without addressing the examiner's motivation as to why the user at the receiver station would resubmit a subsequent request for the alternative (actually same) content transmission, the rejection accordingly still applies.

Applicant did not argue the dependent claims. Therefore, claims 1-3, 6 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan.

It is noted that the applicant did not refute the examiner's reason for obviousness in either of the other two rejections. Instead in Gruse, he only argues by describing the system of Gruse and how it allegedly is not applicable to what applicant describes as his invention of claim 4 (single paragraph spanning pages 6 and 7 of his response). Applicant did not address what the examiner stated in his rejection at all, which covers features disclosed by Gruse with respect to applicant's claimed features, and motivation for obviousness. Therefore, that rejection still applies, and claims 4, 5, 7 and 12 accordingly stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gruse et al., as applied in the last Office action.

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Regarding the rejection based on Schindler, applicant argues that Schindler does not describe any specific circuitry for carrying out his method of avoiding duplicate recording of broadcast information (page 7 of his response). Applicant therefore essentially argues that because Schindler does not specify circuitry for that process, he then does not or cannot carry out his method. (To say that Schindler does not disclose hardware therefor is at the outset erroneous.)

This argument is illogical and accordingly unpersuasive. Applicant apparently failed to peruse the disclosure carefully enough to make the reasonable, allowable, and appropriate inferences the examiner made, particularly noting the context of the text pointed out in the first Office action (namely col. 4 lines 17-19). Throughout that disclosure (spanning lines 4-25 of column 4) computer hardware and associated programming is described (regardless of the text being in the Summary of the Invention). Applicant also fails to comment on the computer 118 of Schindler referred to by the examiner in that last Office action, which is included (though not by numeral reference) in the text of column 4.

Furthermore, applicant does not argue the specific features in claims 8-10 and 13, which contain a limited description of hardware, but instead describes his "invention". Moreover, claim 13 recites no hardware apart from general program storage and associated instructions for carrying out a method, which is nothing more specific than what the examiner just referred to in column 4 of Schindler.

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Therefore, claims 8-10 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schindler et al., as applied in the last Office action.

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should make particular note that Seo identifies failed broadcast communication (therefore failed recording/storage the receiver) and accordingly retransmits the data.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (703)-305-4374. The examiner can normally be reached on Monday through Friday from 6:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile, can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone (703) 306-0377.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:


(703) 872-9314, (for formal communications; please mark "EXPEDITED
PROCEDURE"; for informal or draft communications, please label
"PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Victor R. Kostak

Primary Examiner



VRK

8/20/03